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HARRINGTON & SMITH, LLP  
4 RESEARCH DRIVE  
SHELTON, CT 06484-6212

EXAMINER

GARG, YOGESH C

ART UNIT PAPER NUMBER

3625

DATE MAILED: 03/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/559,499

Applicant(s)

PIIKIVI ET AL.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. Amendment B, paper # 9, received on 02/10/2003 is acknowledged and entered. Claims 1 and 5 have been amended. Currently claims 1-32 are pending for examination.

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### *Response to Arguments*

2. Applicant's arguments, see pages 3-4, filed on 2/10/2003, with respect to the rejection(s) of claim(s) 1-32 under 103 have been fully considered and are persuasive in stating that Wang cannot be combined with Lazaridis. Therefore, the Final rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the fact that Wang teaches automatic detection of a message received from a commerce site based on the same rationale as disclosed in the application. Wang substantially discloses the invention, including automatically detecting the presence of a mobile device for user authentication. Wang further discloses that the transaction program TP downloaded on the requesting device- a computer terminal- between the commerce site server and the mobile station i.e. PEAD- includes an executable program and detects the presence of approval device, if that approval

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device is embedded or external and further communicates with PEAD-the mobile station-to obtain approval/authentication data (see col.15, line 40-col.16, line 67). Therefore, it is implied that the requesting device, a computer terminal between the commerce site and the mobile station with the help of the Transaction program TP automatically detects the message from the server requesting authentication of the user or requiring other data like user's signature certificate, etc. and communicates with the mobile station –PEAD. This is in line with the rationale used in the application to detect the message from the server and redirect it to the mobile station (see page 4, lines 14-20 and page 5, lines 4-9, where a software module or plug-in the computer PC1 recognizes the message from the server and redirects it to mobile station. Further, it would have been obvious to parse messages using MIME standard in view of Lazaridis and to enter PIN numbers via a keypad by a user into a mobile station in view of Schwartz et al. (US Patent 6,473,609). Also claims 1-6, 21 and 31-32 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is mostly connected, to make and/or use the invention and as analyzed below.

It is a non-final rejection.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the appropriate paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to

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which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6, 21 and 31-32 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is mostly connected, to make and/or use the invention. With regards to claim 1, it does not contain the critical feature of using a mobile station by the user to conduct electronic commerce. Page 4, lines 10-20, page 5 line 4, disclose that as per the teachings of this invention the authentication of the user is carried out by the mobile station instead by the PC 1. Authentication is done using a keypad 16 and display 14 in a mobile station 10, which could be a cellular phone or a personal communicator. Communication between mobile station and the commerce site is conducted via computer PC 1. Computer PC 1 acts as an access point to enable the user browse the Internet and contact the commerce site for conducting electronic commerce such as to implement authentication of the user, on-line purchase of goods or services, order tickets, make payments. Therefore, the examiner considers the feature of user sending a request from mobile station to the computer PC 1, which acts as a conduit or access point to enable Internet browsing, a critical step in using the claimed invention. The examiner suggests to insert the step-- sending a request from mobile station via a link to a computer to contact a commerce related site--to overcome this rejection.

***Claim Rejections - 35 USC § 102***

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(e)

**Recent Statutory Changes to 35 U.S.C. § 102(e)**

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at [www.uspto.gov](http://www.uspto.gov) or call the Office of Patent Legal Administration at (703) 305-1622.

5. Claims 1, 3-7, 10-16, 18-20, 23-25, and 28-32 are rejected under 35

U.S.C. 102(e) as being anticipated by Wang.

With regards to claims 1, 3-7, 10-16, 18-20, 23-25, and 28-32, Wang discloses a method and a system for approving transactions that involves sending a transaction authorization request over a bi-directional link between a vendor server and a portable electronic authorization device such as a cellular phone. A user with an Internet-enabled mobile device such as a cellular phone can contact a merchant's Internet server through a wireless gateway implemented using a short range wireless communication capability such as Bluetooth, and the merchant server can transmit encrypted messages to the user's cellular phone in response via a Requesting Device 202 (FIG.2, which is a computer terminal, see at least col.4, lines 56-61) or 904 (see FIG.9A, col.15, lines 19-40). The user's mobile station can have pre-installed software for performing electronic transaction verification, or the merchant server can download a transaction program TP to the Requesting Device (see col.15, lines 41-col.20, line 43) to enable the electronic transaction. The user can generate and send to the remote

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server user identification and authentication data, such as the user's digital signature, and authorization of the transaction. In response, the merchant site can download authorization confirmation and any electronic tokens required for accessing the service, such as an electronic ticket, to the user's mobile device for future service authorization (see at least Fig. 3A, Fig. 5B, Fig. 7A, Fig. 9A, col. 14 line 63 - col. 15 line 47, col. 16, lines 7 - col. 17 line 19, col. 18, line 33 - col. 19 line 52).

Wang further discloses automatically detecting the presence of a mobile device for user authentication. Wang shows that the transaction program TP downloaded on the requesting device- a computer terminal-between the commerce site server and the mobile station i.e. PEAD-includes an executable program and detects the presence of approval device, if that approval device is embedded or external and further communicates with PEAD-the mobile station-to obtain approval/authentication data (see col.15, line 40-col.16, line 67). Therefore, it is implied that the requesting device, a computer terminal between the commerce site and the mobile station with the help of the Transaction program TP automatically detects the message from the server requesting authentication of the user or requiring other data like user's signature certificate, etc. and communicates with the mobile station -PEAD. This is in line with the rationale used in the application to detect the message from the server and redirect it to the mobile station (see page 4, lines 14-20 and page 5, lines 4-9, where a software module or plug-in the computer PC1 recognizes the message from the server and redirects it to mobile station.



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***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 21-22 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Donoho. et al. (US Patent 6,256,664), hereinafter referred to as Donoho.

With regards to claims 21 and 26-27, Wang teaches a method for conducting communication with a commerce related site on Internet as disclosed and analyzed in claims 1 and 22 above. Wang does not disclose parsing messages using MIME standard. However, parsing messages using MIME is an old and well-known practice in the field of computer related messaging on Internet as explicitly disclosed in Donoho (see at least, col.14, lines 29-49, col.22, line 1-col.31, line 14). Donoho expressly teaches the use of MIME standard and parsing messages to transport files over the Internet. It would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Wang to include the feature of parsing messages and using MIME standard to transport messages/electronic mails/packages over the Internet as explicitly disclosed in Donoho.

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With regards to claim 22, all limitations correspond to the limitations of claims 21 and 27, as analyzed and rejected above and therefore the same rationale is used to reject claim 22.

8. Claims 2, 8, 9, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Ladd et al. (US 6,269,336), hereinafter referred to as Ladd.

Wang, as discussed above, substantially provides the claimed invention, including entering PIN numbers via a keypad by a user of an ATM for authentication by comparing the PIN with a PIN stored at a remote computer, but fails to provide a user entering a PIN into a mobile station. Ladd teaches a mobile station such as a mobile phone, PDA or pager, that prompts a user to enter a unique PIN for user identification. It would have been obvious to one having ordinary skill in the art at the time of the invention to combine Wang's electronic transaction system with the teaching of Ladd regarding prompting a user to enter a PIN at a mobile station. Doing so would provide a simple means to identify a user and prevent unauthorized use of a mobile station, thus increasing user security.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Patent 6,473,609 B1 to Schwartz et al. teaches a method and system for conducting electronic commerce, comprising the steps of operating a computer to contact a commerce-related site using a browser (see at least FIG.1, 110, col.5, lines 8-25, "...a personal computer PC 110 and a network server...personal computer 110 runs a ...browser", col.5, lines 48-61, "...Link server device 114.....wireless data server or network gateway server, may be a workstation or a personal computer...loaded with many processes...implementing the present invention...", FIGs. 3A, and 3B) automatically detecting a presence of a message received from the commerce-related site that requires, as a response, an authentication of a user, in response sending a message from the computer to a mobile station over a bi-directional link, wherein the mobile station comprises of a user interface and an application, in response to receiving the message over the link, generating a user authentication message in the mobile station, passing the user authentication message from the mobile station to the computer over the link and sending user authentication information from the computer to the commerce-related site using the browser (see at least col.2, lines 30-38, lines 50-62, col.3, line 5-col.4, line 30, col.5, lines 48-61, col.17, line 52-col.21, line 29, FIGs 1, 2A, 2B, 3A, 3B, 9A, 9B, 9C, 9D, 9E, 9F and 9G. Link server/computer contacts the network server 104 via Landnet 114. Network server 114 corresponds to the commerce-related site and Mobile devices 106-1...with interface engine 364 correspond to a mobile station with a user interface in the application). Schwartz also discloses that the computer operates to prompt the user to enter a PIN into said computer/mobile station, said computer transmits the entered PIN to said mobile station over the link and where

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a user authentication module compares the entered PIN to a PIN stored in the mobile station (see at least col.10, lines 36-53, col.11, lines 26-41, col.17, lines 58-65. Note: Here, Schwartz discloses that the communication session can be initiated by either computer-link server-or the mobile device. When the computer-link server-initiates the communication device it sends a message to mobile station including a mobile station identification for authentication, and this corresponds to entering PIN and transmitting it to mobile station for comparison and authentication as claimed in the application.).

Claims 1-2, 7-8, 9, 16-17, and 31 are anticipated by Schwartz et al.

(ii) US PG PUB.: 2002/0022453 A1 to Balog et al. teaches a method and a system for delivering and routing of content to mobile devices from a content server via Internet and mobile devices communicate with another using Bluetooth wireless technology.

(iii) US Patent 6,185,682 to Tang teaches a method and a system to implement an authentication system between a commerce site and a mobile device via a computer terminal (see at least col.2, line1-col.3, line 60, col.4, lines 45-58, " the station 102 may be split into, for assistance, a user station and an access station.....user station may, for instance, be formed by PDA.....access station includes a smart-card reader").

(iv) US Patents 6,442,532 to Kawan and 6,098,053 to Slater teach a method and a system for conducting electronic financial transactions using wireless technology.

(v) Press release, " Bluetooth Technology Set To Re-Define The Personal Communication Market ", Phillips Business Information's Communications Standards News; Potomac; Dec 20, 1999, 2 pages, extracted from Internet from

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<http://proquest.umi.com> on 02/25/2003 and McLucas, Kate; "Accessorize the brand-new you," InfoWorld; Framingham; Aug 23, 1999 extracted from Internet from <http://proquest.umi.com> on 02/25/2003 teach the use of Bluetooth technology for wireless communication for networking between PCs, mobile phones and other portable devices to keep their data synchronized between mobile devices and computers and to provide an Internet bridge between mobile devices and web sites.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Yogesh C Garg  
Examiner  
Art Unit 3625

YCG  
February 27, 2003

  
WYNN W. COGGINS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600